

Remarks

This Application has been carefully reviewed in light of the Final Office Action mailed September 20, 2006. Applicants believe all claims are allowable without amendment and respectfully provide the following remarks. Applicants respectfully request reconsideration and allowance of all pending claims.

I. The Non-Statutory Double Patenting Rejection should be Withdrawn

The Examiner rejects Claims 1-45 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-30 of U.S. Patent 6,961,323 to Xu et al (“Xu”). Applicants respectfully traverse this rejection.

A. The Obviousness-Type Double Patenting Standard

In determining whether a non-statutory basis exists for a double patenting rejection, the first question to be asked is – does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the patent? *See* M.P.E.P. § 804(II)(B)(1). An obviousness-type double patenting rejection is proper only when the claimed subject matter is not patentably distinct from the subject matter claimed in a commonly owned patent. *Id.* The term “distinct” means two or more subjects as disclosed are related, for example, as combination and sub-combination thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, and are patentable (novel and unobvious) over each other (though they may each be unpatentable because of prior art). *See* M.P.E.P. § 802.01. ***Any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. § 103 obviousness determination.*** *Id.* (emphasis added) A double patenting rejection must rely on a comparison with the claims in an issued or to be issued patent, whereas an obviousness rejection based on the same patent under 35 U.S.C. § 102(e)/103(a) relies on a comparison with what is disclosed (whether or not claimed) in the same issued patent. *See* M.P.E.P. § 804(III).

The Office Action should make clear the differences between the inventions defined by the conflicting claims, and the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claims at issue would have been an obvious variation of the invention defined in a claim in the patent. *See* MPEP § 804. This analysis requires a comparison of each rejected claim in the application with a claim in the patent. *See id.*

B. The Applicable Obviousness Standard under 35 U.S.C. § 103

The question raised under 35 U.S.C. § 103 is whether the cited reference (*i.e.*, *Xu*) taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various references, which is certainly not the case here as the Examiner acknowledges, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference to arrive at the claimed invention. It is clear based at least on the many distinctions discussed below that the proposed modifications to the claims of *Xu* do not, taken as a whole, suggest the claimed invention, taken as a whole.

The M.P.E.P. sets forth the strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of prior art references. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all the claim limitations." M.P.E.P. § 2142, 2143. The teaching, suggestion, or motivation for the modification or combination and the reasonable expectation of success must both be found in the prior art and cannot be based on an applicant's disclosure. *See Id.* (citations omitted). "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the

claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art at the time of the invention.” M.P.E.P. § 2143.01. Even the fact that references can be modified or combined does not render the resultant modification or combination obvious unless the prior art teaches or suggests the desirability of the modification or combination. *See Id.* (citations omitted). Moreover, “To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03 (citations omitted).

The governing Federal Circuit case law makes this strict legal standard even more clear.¹ According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding.” *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). “Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.” *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the “range of sources available . . . does not diminish the requirement for actual evidence.” *Id.* Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432. *See also In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (holding a *prima facie* case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the

¹ Note M.P.E.P. 2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at" the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, "The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." M.P.E.P. § 2142. The governing Federal Circuit cases are equally clear. "A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.'" *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted). In *In re Kotzab*, the court noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. *See id.* *See also, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a

suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted).

C. A *Prima Facie* Case of Obviousness has not been Established

Applicants respectfully submit that a *prima facie* case of obviousness has not been established with respect to Claims 1-45 of the present Application in view of Claims 1-30 of *Xu*. Thus, Applicants respectfully request the Examiner to withdraw the obviousness-type double patenting rejection.

The Examiner acknowledges that the *Xu* claims are not identical to the claims at issue but states that they are not patentably distinct from each other. Applicants note that the Examiner still has not compared each of the limitations of each of the rejected claims to the *Xu* claims. Had there been such a comparison, it would show that Claims 1-45 of the present application are not merely obvious variations of Claims 1-30 of the *Xu* patent.

For example, independent Claim 1 of the present Application recites “predicting communication paths for a plurality of the participants” and “selecting a second multipoint control unit is selected to host the multipoint conference, if the first multipoint control unit does not have the multipoint control unit resource requirement available at the scheduled start time,” which are not specifically recited in Claims 1-30 of *Xu*. These limitations are not obvious variations of, and are therefore patentably distinguishable from, Claims 1-30 of *Xu*.

The Examiner argues that it would have been obvious to modify the claims of *Xu* to recite “predicting communication paths for a plurality of participants,” as recited in Claim 1. (See Office Action, Page 3) The Examiner cites references that purportedly disclose predicting communication paths for a plurality of participants (although Applicants do not concede that these references actually disclose this limitation). (See Office Action, Page 3) Applicants respectfully submit that the Examiner’s attempt to modify the claims of *Xu*, made

with the benefit of hindsight with Applicants' claims in view, is insufficient to establish a *prima facie* case of obviousness. In particular, Applicants submit that there has been no showing of the required teaching, suggestion, or motivation to modify the claims of *Xu* to recite at least the above-identified limitation recited in Claim 1 of the present Application. Accordingly, even assuming that the references cited by the Examiner do disclose "predicting communication paths for a plurality of participants," as recited in Claim 1, because the Examiner has not demonstrated the requisite teaching, suggestion, or motivation to modify the claims of *Xu* in the manner proposed, Applicants respectfully submit that the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness (or in this case, a *prima facie* case of obviousness-type double patenting) have not been met.

In addition, the Examiner argues that it would have been obvious to modify the claims of *Xu* to recite "selecting a second multipoint control unit is selected to host the multipoint conference, if the first multipoint control unit does not have the multipoint control unit resource requirement available at the scheduled start time," as recited in Claim 1. (*See* Office Action, Pages 7-8) The Examiner cites U.S. Patent 5,933,417 to Rottoo ("*Rottoo*") as allegedly disclosing "using a second unit to host the conference." (Office Action, Pages 7-8)

First, Claim 1 does not simply recite "using [a] second unit to host the conference," as stated by the Examiner, but instead recites "selecting a second multipoint control unit is selected to host the multipoint conference, if the first multipoint control unit does not have the multipoint control unit resource requirement available at the scheduled start time." Second, Applicants respectfully disagree that the cited portion of *Rottoo* (3:48-4:30) discloses these limitations. Instead, the cited portion of *Rottoo* appears to disclose that if the requested resources are not available for the full duration of the conference, then the reservation will not be accepted. (*See Rottoo*, 4:11-30) It does not appear that the cited portion of *Rottoo* even contemplates "selecting a second multipoint control unit is selected to host the multipoint conference, if the first multipoint control unit does not have the multipoint control unit resource requirement available at the scheduled start time," as recited in Claim 1. Third,

Applicants respectfully submit that the Examiner's attempt to modify the claims of *Xu*, made with the benefit of hindsight with Applicants' claims in view, is insufficient to establish a *prima facie* case of obviousness. In particular, Applicants submit that, other than the general statement "in order to support reserving conference resources," there has been no showing of the required teaching, suggestion, or motivation to modify the claims of *Xu* to recite at least the above-identified limitation recited in Claim 1 of the present Application. Accordingly, since the Examiner has not demonstrated the requisite teaching, suggestion, or motivation to modify the claims of *Xu* in the manner proposed, Applicants respectfully submit that the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness (or in this case, a *prima facie* case of obviousness-type double patenting) have not been met.

Claims 13, 26, 29, 33, 36, 40, and 43 are each independent claims that include a limitation generally directed to predicting communication paths for a plurality of participants, and Claims 2-12, 14-25, 27-28, 30-32, 34-35, 37-39, 41-42 and 44-45 each depend, either directly or indirectly, from Claims 1, 13, 26, 29, 33, 36, 40 and 43, respectively. Accordingly, Claims 1-45 are each patentably distinguishable from Claims 1-30 of *Xu*.

Applicants again note that to the extent that the Examiner intends to maintain the obviousness-type double patenting rejection of Claims 1-45 over *Xu*, Applicants respectfully request that the Examiner provide a comparison of each rejected claim in the application with a claim in *Xu*, in accordance with MPEP § 804 (stating that the comparison between the claims of the patent and the claims of the patent application requires a comparison of each rejected claim in the application with a claim in the patent), 37 C.F.R. 1.104 (c)(2) and 35 U.S.C. § 132. The Examiner did not provide this analysis in either the previous Office Action or the current Office Action (despite Applicants' request in the previous Response).

For at least these reasons, Applicants respectfully request that the Examiner withdraw the non-statutory obviousness-type double patenting rejection of independent Claims 1, 13, 26, 29, 33, 36, 40, and 43 and their dependent claims.

II. Claim 1 Complies with 35 U.S.C. § 112, Second Paragraph

The Examiner rejects Claim 1 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention. Applicants respectfully disagree.

The Examiner contends that because multiple references to a “multipoint conference” exist in Claim 1, it is not clear which “multipoint conference” is referred by the limitations “the multipoint conference.” As Applicants discussed in the previous Response, the reference to “a multipoint conference” in line 3 of Claim 1, as stated by the Examiner, is actually a reference to “a multipoint conference reservation.” Each instance of “the multipoint conference” properly refers to “a multipoint conference” in lines 1 and 2 of Claim 1. Therefore, Claim 1 particularly points out and distinctly claims the invention, and Applicants respectfully request that this rejection of Claim 1 be withdrawn.

This argument was presented by Applicants in the previous Response. The Examiner did not provide any response to this argument in the Final Office Action, other than to reiterate substantially verbatim the rejection as presented in the previous Office Action and to note that the rejection has been maintained. Applicants maintain that Claim 1 is definite for at least those reasons discussed above.

Moreover, if the Examiner intends to maintain this rejection, the Examiner must withdraw the Finality of the current Office Action because the Examiner did not respond to the substance of Applicants’ argument as presented in the previous Office Action. Applicants note that “[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and ***answer the substance of it.***” M.P.E.P. § 707.07 (f) (emphasis added). Applicants respectfully submit that the Examiner did not take note of Applicants’ argument or answer the substance of Applicants’ argument. Because the Examiner did not take note of or address Applicants’ argument in this Office Action, Applicants respectfully submit that the current Office Action is deficient and that its

finality must be withdrawn. Applicants respectfully request that the Examiner address Applicants' arguments in the next Office Action if the Examiner does not change the or withdraw the rejection or, more appropriately, issue a Notice of Allowance.

III. The Claims are Allowable over the Section 103 Rejections

The Examiner rejects Claims 1, 3-4, and 7 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pub. No. 2001/0009014 by Savage III, et al. ("*Savage*") in view of *Rottoo*. Applicants respectfully traverse these rejections.

At the outset, Applicants address the Examiner's Note appearing on page 5 of the Office Action. "To establish *prima facie* obviousness of a claimed invention, ***all the claim limitations*** must be taught or suggested by the prior art." M.P.E.P. § 2143.03 citing *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974) (emphasis added). "***All words in a claim must be considered*** when judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 citing *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970) (emphasis added). To the extent that the Examiner is suggesting at page 5 of the Office Action that the Examiner is not required to find a reference that discloses, teaches, or suggests "selecting a second multipoint control unit to host the multipoint conference, if the first multipoint control unit does not have the multipoint control unit resource requirement available at the scheduled start time," as recited in Claim 1 for example, Applicants respectfully disagree. The above-cited authority makes clear that the Examiner must find a reference that discloses, teaches, or suggests all the claim limitations, including "selecting a second multipoint control unit to host the multipoint conference, if the first multipoint control unit does not have the multipoint control unit resource requirement available at the scheduled start time," as recited in Claim 1 for example.

Regarding independent Claim 1, which Applicants discuss as an example, Applicants maintain that, at a minimum, the proposed *Savage-Rottoo* combination fails to disclose, teach, or suggest at least the following limitations:

- predicting communication paths for a plurality of the participants; and

- estimating a multipoint control unit resource requirement.

The Examiner argues that *Savage* discloses “predicting communication paths for a plurality of the participants.” (See Office Action Pages 4-5 and 9) Applicants respectfully disagree. *Savage* merely discloses a server that “dynamically provides virtual connections among the plurality of clients for transmission of data and thereby facilitates a conference including the plurality of clients.” (*Savage*, Paragraph 19) The virtual connections disclosed in *Savage* actually facilitate the conference; they have nothing to do with predicting communication paths for a plurality of participants. (See *id.*) Applicants maintain this argument from the previous Response.

In response to this argument, the Examiner states the following:

Savage-Lipstream discloses the relied upon limitations, i.e., predicting communication paths for a plurality of the participants, e.g., a particular conference for number of users/clients is set up based on usage of a dispatcher server that (does not know how many users/clients will be participating) guesses which media server among multiple media servers support the communication for the respective user of the conference. The guessing of which media servers is used for the conference also includes guessing of whether a channel is supported by the respective media server in order to further estimate the capacity of the path for communication. The dispatcher server also guesses the number of clients that will be participating in the conference, wherein each client needs a respective communication path for the conference including usage of bandwidth units (e.g., paragraphs 54 and 19).

(Office Action, Page 4)

First, Applicants respectfully submit that the cited portions of *Savage* do not disclose, teach, or suggest the majority of the above-quoted statements made by the Examiner. For example, nowhere do the cited portions disclose, teach, or suggest that the dispatcher “guesses” which media server among multiple media servers support the communication for the respective user of the conference. *Savage* certainly fails to disclose that the “guessing” of which media servers is used for the conference includes guessing of whether a channel is supported by the respective media server in order to further estimate the capacity of the path

for communication. Therefore, the Examiner is necessarily attempting to modify the disclosure of *Savage*. If “common knowledge” or “well known” art is relied upon by the Examiner to modify *Savage*, Applicants respectfully request that the Examiner provide a reference pursuant to M.P.E.P. § 2144.03 to support such an argument. If the Examiner relies on personal knowledge to supply the required motivation or suggestion to modify *Savage*, Applicants respectfully request that the Examiner provide an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.

The Examiner also argues that *Savage* discloses “estimating a multipoint control unit resource requirement,” as recited in Claim 1. (See Office Action, Page 7, ¶ 13) Applicants respectfully disagree. In response to Applicants’ argument from the previous Response, the Examiner states the following:

Savage-Lipstream also discloses estimating a multipoint control unit resource requirement, e.g., regarding the particular conference the dispatcher server estimates the available capacity of a media server in a variety of ways including estimating the media server’s capacity of the number of CPU units and/or bandwidth units (e.g., paragraphs 54, 20, and 75).

(Office Action, Pages 4-5)

Applicants maintain that the cited portions of *Savage* fail to disclose, teach, or suggest “estimating a multipoint control unit resource requirement,” as recited in Claim 1. For example, paragraph 20 of *Savage* merely discloses determining whether the requested conference is currently being facilitated on any of a plurality of media servers. Applicants maintain that determining whether a conference is being held on a server does not disclose, teach, or suggest estimating a multipoint control unit resource requirement. As another example, paragraph 54 of *Savage* appears to disclose determining *the capacity* of the media server. Applicants submit that determining the capacity of the media server does not disclose, teach, or suggest “estimating a multipoint control unit resource *requirement*,” as recited in Claim 1. As another example, paragraph 75 of *Savage* appears unrelated to “estimating a multipoint control unit resource requirement,” as recited in Claim 1.

For at least these reasons, Applicants respectfully submit that the proposed *Savage-Rottoo* combination fails to disclose, teach, or suggest each and every limitation recited in independent Claim 1. For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claim 1 and its dependent claims.

Moreover, Applicants respectfully submit that the Examiner has not shown the requisite teaching, suggestion, or motivation in either *Savage* or *Rottoo*, or in the knowledge generally available to one of ordinary skill in the art at the time of Applicants' invention, to combine or modify *Savage* and *Rottoo* in the manner proposed by the Examiner. Claim 1 is allowable for at least this additional reason.

Applicants respectfully direct the Examiner's attention to Section I.B above, which sets forth the heavy burden incumbent on the Examiner for demonstrating a *prima facie* case of obviousness.

The Examiner states:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Savage-Lipstream* with the teachings of *Rottoo-General-DataComm* in order to facilitate usage of determining done at approximately a scheduled start time and for a duration of the multipoint conference because the determination would provide information on whether the necessary resource for conference is available or not. The scheduled start time and the duration of the multipoint conference would be used to know when and how long the resource would be required to support the multipoint conference.

(Office Action, Page 10)

The Examiner has merely proposed an alleged advantage of combining *Rottoo* with *Savage* (an advantage which Applicants do not admit is even disclosed in the cited references or could be achieved by combining these references in the manner the Examiner proposes). The Examiner has not pointed to any portions of either *Savage* or *Rottoo* that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to incorporate the

particular techniques disclosed in *Rottoo* with the cited disclosure in *Savage*. It certainly would not have been obvious to one of ordinary skill in the art at the time of invention *to even attempt* to, let alone *to actually*, modify or combine the particular techniques disclosed in *Savage* with the cited disclosures in *Rottoo* in the manner proposed by the Examiner.² Applicants respectfully submit that the Examiner's attempt to modify or combine *Savage* with *Rottoo* appears to constitute the type of impermissible hindsight reconstruction of Applicants' claims, using Applicants' claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

As demonstrated above, Applicants respectfully submit that *Savage* is wholly inadequate as a reference against independent Claim 1. Thus, even if *Rottoo* did disclose the portions of Claim 1 that the Examiner asserts it discloses, and even assuming for the sake of argument that there was the required teaching, suggestion, or motivation to combine *Savage* with *Rottoo* as the Examiner proposes, the proposed *Savage-Rottoo* combination would still fail to disclose, teach, or suggest the limitations specifically recited in independent Claim 1, as is required under the M.P.E.P. and the governing Federal Circuit cases for a *prima facie* case of obviousness.

For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claim 1 and its dependent claims.

The Examiner rejects Claims 2 and 6 under 35 U.S.C. §103(a) as being unpatentable over *Savage* and *Rottoo* in view of U.S. Patent 6,411,601 to Shaffer, et al. ("*Shaffer*"). The Examiner rejects Claim 5 under 35 U.S.C. §103(a) as being unpatentable over *Savage* and *Rottoo* in view of "Official Notice." The Examiner rejects Claims 8-11, 13-14, and 17-20 under 35 U.S.C. §103(a) as being unpatentable over *Savage* and *Rottoo* in view of U.S. Patent

² If "common knowledge" or "well known" art is relied upon by the Examiner to combine or modify the references, Applicants respectfully request that the Examiner provide a reference pursuant to M.P.E.P. § 2144.03 to support such an argument. If the Examiner relies on personal knowledge to supply the required motivation or suggestion to combine or modify the references, Applicants respectfully request that the Examiner provide an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.

6,021,263 to Kujoory, et al. (“*Kujoory*”). Applicants respectfully traverse each of these rejections.

Claims 2, 5-6, and 8-11 each depend from independent Claim 1, which Applicants have shown above to be clearly allowable over the proposed *Savage-Rottoo* combination. It does not appear that *Shaffer*, *Kujoory*, or the Official Notice taken by the Examiner makes up for at least the above-discussed deficiencies of the proposed *Savage-Rottoo* combination with respect to independent Claim 1. Thus, dependent Claims 2, 5-6, and 8-11 are allowable at least because they depend from an allowable independent claim. In addition, Claims 2, 5-6, and 8-11 recite further patentable distinctions over the proposed combinations. To avoid burdening the record and in view of the clear allowability of independent Claim 1, Applicants do not specifically discuss these distinctions in this Response. However, Applicants reserve the right to discuss these distinctions in a future Response or on Appeal, if appropriate. Furthermore, Applicants do not admit that the various proposed combinations of *Savage*, *Rottoo*, *Shaffer*, *Kujoory*, and any other references cited by the Examiner are possible or that the Examiner has demonstrated the required teaching, suggestion, or motivation to combine these references. For at least these reasons, Applicants respectfully request reconsideration and allowance of dependent Claims 2, 5-6, and 8-11.

Regarding independent Claim 13, the Examiner argues that each of the limitations of Claim 13 is disclosed by the proposed *Savage-Rottoo-Kujoory* combination. As discussed above, *Savage* does not disclose, teach or suggest predicting communication paths and estimating network resource requirements in the manner recited in Claim 1. Moreover, *Savage* also does not disclose, teach, or suggest selecting a second multipoint control unit to host the multipoint conference if the first communication path does not include the estimated network resource requirement at approximately the scheduled start time and for the estimated duration. While *Savage* may disclose the usage of a plurality of media servers and a determination of whether any one of such servers is active, (*see Savage*, paragraph 40), it is a mischaracterization of *Savage* to assert that it discloses, teaches or suggests the limitation of Claim 13 whereby the second multipoint control unit is selected if the first communication

path does not include the estimated network resource requirement at approximately the scheduled start time and for the estimated duration. Applicants respectfully submit that the cited portions of *Rottoo* and *Kujoory* do not appear to make up for at least these deficiencies of *Savage*. Moreover, Applicants do not admit that the various proposed combinations of *Savage*, *Rottoo*, and *Kujoory* is possible or that the Examiner has demonstrated the required teaching, suggestion, or motivation to combine these references. For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claim 13 and its dependent claims.

The Examiner rejects Claims 16, 26-31, 33-38, and 40-45 under 35 U.S.C. § 103(a) as being unpatentable over *Savage*, *Rottoo*, and *Kujoory* in view of *Shaffer*. The Examiner rejects Claim 15 under 35 U.S.C. § 103(a) as being unpatentable over *Savage*, *Rottoo*, and *Kujoory* in view of “Official Notice.” The Examiner rejects Claim 12 under 35 U.S.C. § 103(a) as being unpatentable over *Savage* and *Rottoo* in view of U.S. Patent 6,728,365 to Li, et al. (“*Li*”). The Examiner rejects Claim 21 under 35 U.S.C. § 103(a) as being unpatentable over *Savage*, *Rottoo*, and *Kujoory* in view of *Li*. The Examiner rejects Claims 22-25 under 35 U.S.C. § 103(a) as being unpatentable over *Savage*, *Rottoo*, and *Kujoory* in view of “Official Notice.” The Examiner rejects Claims 32 and 39 under 35 U.S.C. § 103(a) as being unpatentable over *Savage*, *Rottoo*, *Kujoory*, and *Shaffer* in view of “Official Notice.” Applicants respectfully traverse each of these rejections.

Regarding independent Claim 26, the Examiner argues that each of the limitations of Claim 26 is disclosed by the proposed *Savage-Rottoo-Kujoory-Shaffer* combination. As discussed above, *Savage* fails to disclose, teach, or suggest predicting communication paths for a plurality of participants. Moreover, the combination of *Savage* and *Shaffer* fails to teach estimating a digital signal processor requirement because *Savage* merely determines whether the requested conference is currently being facilitated on any of a plurality of media servers. (See *Savage*, Paragraph 20) The addition of *Shaffer* does not combine with *Savage* to disclose, teach, or suggest, a server operable to estimate a digital signal processor resource

requirement for the multipoint conference. For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claim 26 and its dependent claims.

Regarding independent Claim 29, the Examiner argues that each of the limitations of Claim 29 is disclosed by the proposed *Savage-Rottoo-Kujoory-Shaffer* combination. As discussed above, *Savage* fails to disclose, teach, or suggest predicting communication paths for a plurality of participants. Although, *Savage* mentions bandwidth, it does not disclose teach or suggest estimating corresponding bandwidth requirements associated with a plurality of communication paths, because *Savage* merely determines whether the requested conference is currently being facilitated on any of a plurality of media servers. (*See Savage*, Paragraph 20) Also, *Savage* may disclose the usage of a plurality of media servers and a determination of whether any one of such servers is active, (*see Savage*, paragraph 40), but this does not disclose, teach, or suggest, a server operable to select a second multipoint control unit to host the multipoint conference if the first communication path does not include the estimated bandwidth requirement at approximately the scheduled start time and for the estimated duration. Moreover, Applicants do not admit that the various proposed combinations of references is possible or that the Examiner has demonstrated the required teaching, suggestion, or motivation to combine these references. For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claim 29 and its dependent claims.

Independent Claims 33 and 40 and their respective dependent Claims 34-35 and 41-42 each include limitations generally directed to predicting communication paths for a plurality of participants and estimating a digital signal processor resource requirement for the multipoint conference. The rejection of each of these claims depends on the deficiencies of *Savage* discussed above with regard to Claims 1 and 26. Neither *Rottoo*, *Shaffer*, *Kujoory*, nor *Li* makes up for these deficiencies. Accordingly, independent Claims 33 and 40 are allowable over the proposed combinations cited by the Examiner for at least the same reasons discussed above with regard to Claims 1 and 26. Moreover, Applicants do not admit that the various proposed combinations of references is possible or that the Examiner has

demonstrated the required teaching, suggestion, or motivation to combine these references. For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claims 33 and 40 and their dependent claims.

Independent Claims 36 and 43 and their respective dependent Claims 37-39, and 44-45 each include limitations generally directed to predicting communication paths for a plurality of participants, estimating corresponding bandwidth requirements for a plurality of communication paths, and selecting a second multipoint control unit to host the multipoint conference if the first communication path does not include the estimated bandwidth requirement at approximately the scheduled start time and for the estimated duration. The rejection of each of these claims depends on the deficiencies of *Savage* discussed above with regard to Claims 1, 13, and 29. Neither *Rottoo*, *Shaffer*, *Kujoory*, nor *Li*, makes up for these deficiencies. Accordingly, Claims independent Claims 36 and 43 and their dependent claims are allowable over the proposed combinations cited by the Examiner for at least the same reasons discussed above with regard to Claim 1, 13, and 29. Moreover, Applicants do not admit that the various proposed combinations of references is possible or that the Examiner has demonstrated the required teaching, suggestion, or motivation to combine these references. For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claims 36 and 43 and their dependent claims.

Claim 12, Claims 15-16 and 21-25, Claim 27, Claims 30 and 32, Claim 34, Claims 37 and 39, Claim 41, and Claim 44 dependent from independent Claims 1, 13, 26, 29, 33, 36, 40, and 43, which Applicants have shown above to be clearly allowable over the proposed *Savage-Rottoo* combination. It does not appear that *Shaffer*, *Kujoory*, *Li*, or the Official Notice taken by the Examiner makes up for at least the above-discussed deficiencies of the proposed *Savage-Rottoo* combination with respect to independent Claim 1, the proposed *Savage-Rottoo-Kujoory* combination with respect to independent Claim 13, or the proposed *Savage-Rottoo-Kujoory-Shaffer* combination with respect to independent Claims 26, 29, 33, 36, 40, and 43. Thus, dependent Claims 12, 15-16, 21-25, 27, 30, 32, 34, 37, 39, 41, and 44 are allowable at least because they depend from allowable independent claims. In addition,

Claims 12, 15-16, 21-25, 27, 30, 32, 34, 37, 39, 41, and 44 recite further patentable distinctions over the proposed combinations. To avoid burdening the record and in view of the clear allowability of independent Claims 1, 13, 26, 29, 33, 36, 40, and 43, Applicants do not specifically discuss these distinctions in this Response. However, Applicants reserve the right to discuss these distinctions in a future Response or on Appeal, if appropriate. Furthermore, Applicants do not admit that the various proposed combinations of *Savage*, *Rottoo*, *Shaffer*, *Kujoory*, *Li*, or any other reference cited by the Examiner are possible or that the Examiner has demonstrated the required teaching, suggestion, or motivation to combine these references. For at least these reasons, Applicants respectfully request reconsideration and allowance of dependent Claims 12, 15-16, 21-25, 27, 30, 32, 34, 37, 39, 41, and 44.

In rejecting Claims 5, 15, 22-25, 32 and 39 the Office Action takes Official Notice of particular elements of those claims and asserts that such elements are well-known. Applicants respectfully traverse this Official Notice and disagree with the Office Action regarding the alleged notoriety of these elements. The Examiner has provided references that purportedly support the Examiner's taking of Official Notice. Given the clear allowability of Applicants independent claims, as discussed above, and to avoid burdening the record, Applicants do not comment on the sufficiency of these references at this time. However, Applicants note that they do not acquiesce to the Examiner's taking of Official Notice.

IV. No Waiver

All of Applicants' arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the references cited by the Examiner. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicants are sufficient to overcome the Examiner's rejections.

Conclusion

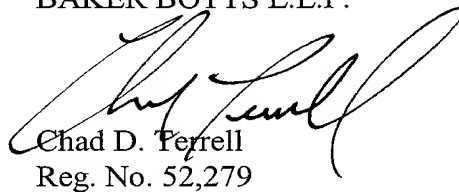
Applicants have made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicants respectfully request full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Chad D. Terrell, Attorney for Applicants, at the Examiner's convenience at (214) 953-6813.

Although no fees are believed due at this time, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

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Date: November 17, 2006

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